

## INTERFERENCE DIGEST

Interference No. 105,208

Paper No.

Name: Joe W. Gray et al.

Serial No.: 10/608,092 (IFW IMAGE)

Patent No.

Title: Chromosome-specific staining to detect genetic rearrangements

Filed: 06/30/03

Interference with Dietz-Band et al.

### DECISION ON MOTIONS

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

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### FINAL DECISION

Board of Patent Appeals and Interferences, \_\_\_\_\_ Dated, \_\_\_\_\_

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Court, \_\_\_\_\_ Dated, \_\_\_\_\_

### REMARKS

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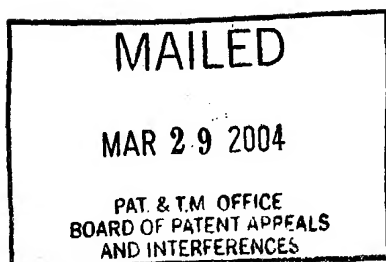
This should be placed in each application or patent involved in interference in addition to the interference letters.



## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Judge Sally Gardner Lane  
Telephone: (703) 308-9797  
Facsimile: (703) 305-0942



Applicant: GRAY  
Application No.: 10/608,092 (IFW IMAGE)  
Filed: 06/30/03  
For: Chromosome-specific staining to detect  
genetic rearrangements  
Accorded benefit: Application 09/765,291, filed  
01/22/01 (IFW IMAGE); Patent 6,280,929, granted  
08/28/01, based on application 08/487,974, filed  
06/07/95; 08/342,028, filed 11/16/94; 08/181,367,  
filed 01/14/94; 08/054,353, filed 04/28/93 and  
07/537,305, filed 06/12/90

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,208.

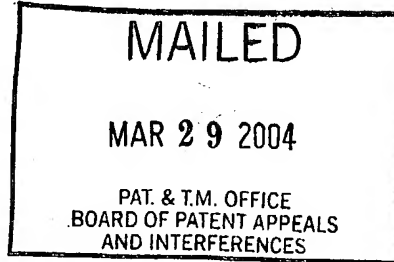
Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

A handwritten signature in cursive script, appearing to read "Sally Gardner Lane", written over a horizontal line.  
SALLY GARDNER LANE  
Administrative Patent Judge

The opinion in support of the decision being  
entered today is not binding precedent of the Board.

Filed by:

Sally Gardner Lane  
Administrative Patent Judge  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942



Paper 1

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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JEANNE DIETZ-BAND,  
WANG-TING HSIEH, and JOHN F. CONNAUGHTON

Junior Party,  
(Patent 6,414,133),

v.

JOE W. GRAY,  
DANIEL PINKEL, and DOUGLAS TKACHUK

Senior Party,  
(Application 10/608,092).

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Patent Interference No. 105,208

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**DECLARATION**

**Part A. Declaration of interference**

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the patent, application, count, and claims designated as corresponding or as not corresponding to the counts appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

**Part B. Judge designated to handle the interference**

Administrative Patent Judge Sally Gardner Lane has been designated to handle the interference. 37 CFR § 1.610(a).

**Part C. Standing order**

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

The Board is conducting a DVD pilot project. A copy of the procedure is attached to this order.

**Part D. Conference call to set dates**

A telephone conference call to set dates for taking action in the interference is scheduled for **2:30 p.m. on 8 June 2004** (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

The Board is conducting an electronic filing pilot project. A copy of the procedure is attached to this order. Counsel should be prepared to discuss participation in the pilot project.

**Part E. The parties involved in this interference are:**

Junior Party

Named inventors: JEANNE DIETZ-BAND  
Deerwood, Maryland

WANG-TING-HSIEH  
Bethesda, Maryland

JOHN F. CONNAUGHTON  
Laytonsville, Maryland

Application: 09/170,630, filed 13 October 1998,  
issued as patent 6,414,133 on 2 July 2002

Title: MULTIPLE FUSION PROBES

Assignee: Ventana Medical Systems, Inc.

Accorded Benefit: None

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: JOE W. GRAY  
Livermore, CA

DANIEL PINKEL  
Walnut Creek, CA

DOUGLAS TKACHUK  
Livermore, CA

Application: 10/608,092 filed 30 June 2003 (IFW IMAGE)

Title: CHROMOSOME-SPECIFIC STAINING TO DETECT  
GENETIC REARRANGEMENTS

Assignee: None of record

Accorded Benefit: US 09/765,291, filed 22 January 2001 (IFW IMAGE);  
US 08/487,974, filed 7 June 1995,  
issued as patent 6,280,929 on 28 August 2001;  
US 08/342,028, filed 16 November 1994;  
US 08/181,367, filed 14 January 1994;  
US 08/054,353, filed 28 April 1993; and  
US 07/537,305, filed 12 June 1990

Attorneys: See last page

Address: See last page

**Part F. Count and claims of the parties**

Count 1

Claim 1 or claim 10 of Dietz-Band (6,414,133) or claim 127 of Gray (10/608,092).

The claims of the parties are:

Dietz-Band: 1-19

Gray: 127-143

The claims of the parties which correspond to Count 1 are:

Dietz-Band: 1-3, 5-12, and 14-19

Gray: 127-143

The claims of the parties which do not correspond to Count 1 are:

Dietz-Band: 4 and 13

Gray: None

**Part G. Heading to be used on papers**

The following heading shall be used on papers filed in the interference. See § 18 of the  
STANDING ORDER.

\_\_\_\_\_ Paper \_\_\_\_\_

Filed on behalf of [name of party]

By: Name of lead counsel, Esq.

Name of backup counsel, Esq.

Street address

City, State, and Zip-Code

Tel:

Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_  
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

(Administrative Patent Judge Sally Gardner Lane)

\_\_\_\_\_  
JEANNE DIETZ-BAND,  
WANG-TING HSIEH, and JOHN F. CONNAUGHTON

Junior Party,  
(Patent 6,414,133),

v.

JOE W. GRAY,  
DANIEL PINKEL, and DOUGLAS TKACHUK

Senior Party,  
(Application 10/608,092).

\_\_\_\_\_  
Patent Interference No. 105,208

\_\_\_\_\_  
TITLE OF PAPER



## **Part H. Summary of dates for taking action**

Times for taking action are set out in the following sections of the STANDING ORDER:

1. § 7: date for identifying lead and backup counsel.
2. § 8: date for identifying any real party in interest.
3. § 9: date for requesting copies of involved and benefit applications and patents.
4. § 17: date for filing list of proposed preliminary motions.
5. § 19: date for accomplishing certain discovery.
6. § 20: date for filing clean copy of claims.
7. § 21: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
8. § 23: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
9. § 33: date for objecting to admissibility of evidence.
10. § 34: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11. § 35: dates when cross-examination can take place.
12. § 45: dates for taking action with respect to settlement discussions

**Part I: Order form for requesting file copies**

**FILE COPY REQUEST**

Interference 105,208

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

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Telephone, including area code: \_\_\_\_\_

**Part J. Signature of administrative patent judge**

  
SALLY GARDNER LANE  
Administrative Patent Judge

29 March 2004  
Arlington, VA

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in the testimony and briefing phases of the interference (ORDERTE6)

PTO Form 850

Copy of pending claims in 10/608,092

Copy of US 6,414,133

Copy of electronic filing order

Copy of DVD evidence order

DECLARE.007  
Revised 12 October 2000  
(replaces DECLARE.006.1)

cc (via overnight carrier):

Attorney for Dietz-Band (real party in interest: Ventana Medical Systems, Inc.):

Huw R. Jones, Esq.  
VENTANA MEDICAL SYSTEMS, INC.  
1910 Innovation Park Drive  
Tucson, AZ 85737

Attorney for Gray:

BURNS, DOANE, SWECKER & MATHIS LLP  
1737 King Street, Suite 500  
Alexandria, VA 22314